

REMARKS

Claims 1-4, 6-24, and 26-102 are now pending in this application. Claims 18-20 were rejected as indefinite under 35 U.S.C. 112, second paragraph. Claims 1, 2, 21 and 22 were rejected as being anticipated by U.S. Patent No. 5,605,696 to Eury et al. ("Eury) under 35 U.S.C. 102(b). Claims 1-17 and 21-34 were rejected as obvious over Eury under 35 U.S.C. 103(a).

Claims 18-20 were held to be allowable if amended so as to overcome the indefiniteness.

Claim 18 is amended and placed in independent form. Claims 18-20 are now allowable.

Claims 5 and 25 are redundant as a result of amendments to claims 1 and 21, respectively, and thus are cancelled.

Rejection under 35 U.S.C. 112

The Examiner rejected claims 18-20 as indefinite on the basis that the non-fouling moiety, as defined in claim 18, can be "R₂-O" or "R₂". The applicants respectfully disagree. The specification at p. 11, lines 6-9, clearly defines the non-fouling moiety derived from a hydroxylated functional compound is "R-O". This definition is clear to one of ordinary skill in the art. For example, poly(ethylene glycol) (PEG) is specified as a hydroxylated functional compound, and the non-fouling moiety is "CH₂CH₂-O" (p. 11, lines 7-9). This is consistent with the non-fouling characteristics of PEG because, as one of ordinary skill in the art would recognize, the unit that imparts non-fouling characteristics to PEG is "CH₂CH₂-O" rather than "CH₂CH₂". As such, claim 18 is definite.

Claim 19 depends on claim 18 and is definite for the same reason as applied to claim 18.

Claim 20 depends on claim 18 and is definite for the same reason as applied to claim 18.

Rejection under 35 U.S.C. 102(b)

Claims 1, 2, 21 and 22 were held to be anticipated by U.S. Patent No. 5,605,696 ("Eury") on the basis that claims 1 and 21 define an article coated with a material having a polymer which is a poly(orthoester), which is described in Eury.

Claim 1, as amended, now defines the diol in the condensation reaction to be a specific diol as defined in the claim. While Eury describes poly(orthorester) as a polymer that can be used to coat a medical device, Eury does not describe a specific poly(orthoester) as defined in claim 1. For this reason, the applicants respectfully submit that Eury does not anticipate claim 1, as amended.

Claim 2 depends on claim 1. Claim 2 is novel over Eury for the same reason as applied to claim 1.

Like claim 1, claim 21 is amended to define the diol in the condensation reaction to be a specific diol as defined in the claim. Claim 21 is therefore novel for the same reason as applied to claim 1.

Claim 22 depends on claim 22. Claim 22 is novel for the same reason as applied to claim 1.

Rejection under 35 U.S.C. 103(a)

Claims 1-17 and 21-34 were rejected as obvious over Eury in view of Engelberg, et al., *Biomaterials*, Vol. 12, pages 292-304 (1990) ("Engelberg") on the basis that the polymer described in Engelberg reads on claims 3, 5, 10-13, 23, 25, 30-33 and that the compounds recited in claims 14 or 34 have very close structural similarities and utilities to that described by

Engelberg. The applicants respectfully disagree if the rejections are applied to the claims as amended.

Claim 1 is to be amended to incorporate the limitations of claim 3. Claim 1 is to be further amended to define the diols in the claim so as to exclude the condensation product of 3,9-dipentylidene-2,4,8,10-tetraoxaspiro-[5,5]-undecane (DETOSU) and the diols *trans*-cyclohexane dimethanol and 1,6-hexane diol. Further, the properties of a polymer depend on not only the chemical structure of its components, but also the spatial configuration and steric hindrance of its components. Polymers formed of different components have different mechanical and thermodynamic properties (Ilan Duvdevani et al., Effect of Chemical Composition of BIMS on the Morphology of its Blends with BR. Part 1. Neat Rubber Blends, 161st American Chemical Society Rubber Division Technical Meeting, Savannah, Georgia, April 29-May 1, 2002; A.K. Sirka and T.G. Lamond, Rubber Chem. Technol. 46: 178 (1973)). Therefore, one of ordinary skill in the art would recognize that polymers made of components with similar structures may not necessarily have similar properties. Accordingly, Eury and Engelberg do not render claim 1, as amended, obvious under 35 U.S.C. 103(a).

Claim 3 depends on claim 1. For the same reason as applied to claim 1, claim 3 is patentable over Eury in light of Engelberg.

Claim 4 depends on claim 1. For the same reason as applied to claim 1, claim 2 is patentable over Eury in light of Engelberg.

Claim 5 is cancelled.

Claim 10 depends on claim 1. For the same reason as applied to claim 1, claim 10 is patentable over Eury in light of Engelberg.

Claim 11 depends on claim 1. For the same reason as applied to claim 1, claim 11 is patentable over Eury in light of Engelberg.

Claim 12 depends on claim 1. For the same reason as applied to claim 1, claim 12 is patentable over Eury in light of Engelberg.

Claim 13 depends on claim 1. For the same reason as applied to claim 1, claim 13 is patentable over Eury in light of Engelberg.

Claim 14 was rejected on the basis that the components forming the poly(orthoester) are similar to the compound as described in Structure 1 of Engelberg. Per the discussion of claim 1, claim 14 is patentable over Eury in light of Engelberg.

Claim 21 defines a method of coating an article using an poly(orthoester) as specified in claim 1. Per the discussion of claim 1, claim 21 is patentable over Eury in light of Engelberg.

Claim 23 depends on claim 21. For the same reason as applied to claim 21, claim 23 is patentable over Eury in light of Engelberg.

Claim 25 is cancelled.

Claim 26 depends on claim 21. For the same reason as applied to claim 21, claim 26 is patentable over Eury in light of Engelberg.

Claim 30 depends on claim 21. For the same reason as applied to claim 21, claim 30 is patentable over Eury in light of Engelberg.

Claim 31 depends on claim 21. For the same reason as applied to claim 21, claim 31 is patentable over Eury in light of Engelberg.

Claim 32 depends on claim 21. For the same reason as applied to claim 21, claim 32 is patentable over Eury in light of Engelberg.

Claim 33 depends on claim 21. For the same reason as applied to claim 21, claim 33 is patentable over Eury in light of Engelberg.

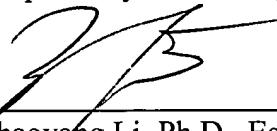
Claim 34 was rejected on the basis that the components forming the poly(orthoester) recited therein are similar to the compound as described in Structure 1 of Engelberg. Per the discussion of claims 1 and 23, claim 34 is patentable over Eury in light of Engelberg.

Accordingly, claims 1-17 and 21-34 are patentable over Eury in light of Engelberg.

Examination and allowance of the claims are respectfully requested. If the Examiner has any suggestions or amendments to the claims to place the claims in condition for allowance, applicant would prefer a telephone call to Zhaoyang Li for approval of an Examiner's amendment instead of receiving a final office action. If the Examiner has any questions or concerns, the Examiner is invited to telephone the undersigned attorney at (415) 393-9885

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Respectfully submitted,



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